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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,192	01/23/2002	Glenn W. Gengel	03424P056	3828

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EXAMINER

PIZARRO CRESPO, MARCOS D

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,192

Applicant(s)

GENGEL ET AL.

Examiner

Marcos D. Pizarro-Crespo

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-22,37-40,42-60,99-102 and 105-111 is/are pending in the application.
- 4a) Of the above claim(s) 4,10-21,39,42-47,49-55,99-102 and 108-110 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9,22,37,38,40,48,56-60,105-107 and 111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,2,4-22,37-40,42-60,99-102 and 105-111 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Attorney's Docket Number: 003424.P056

Filing Date: 1/23/2002

Claimed Foreign Priority Date: none

Applicant(s): Gengel et al.

Examiner: Marcos D. Pizarro-Crespo

DETAILED ACTION

This Office action responds to the amendment filed on 6/26/2006.

Acknowledgment

1. The amendment filed on 6/26/2006, responding to the Office action mailed on 3/22/2006, has been entered. The present Office action is made with all the suggested amendments being fully considered. Accordingly, pending in this Office action are claims 1, 2, 4-22, 37-40, 42-60, 99-102, and 105-111.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 5-8, 22, 37, 38, 40, 48, 56, 58-60, 105, and 111 are rejected under 35 U.S.C. 102(e) as being anticipated by Akita (WO 2001-62517).

4. Regarding claim 1, Akita shows all aspects of the instant invention including an apparatus comprising:

- ✓ A strap **7** including:
 - A first substrate **10** with an opening (see, *e.g.*, fig. 3)
 - An integrated circuit (IC) **4** embedded in the opening and having a conductive pad **21** (see, *e.g.*, fig. 12)
 - ✓ A thin-film dielectric layer **36** formed over a portion of the IC **4** and a portion of the first substrate **10** (see, *e.g.*, fig. 12)
 - ✓ A conductive medium paste **11** formed over the thin-film dielectric layer **36** and attached to the conductive pad **21** via a contact hole, the medium **11** having a greater surface area than the pad **21** (see, *e.g.*, fig. 12)
 - ✓ A large-scale component **6** attached to the medium **11** and electrically coupled to the IC **4**, the component including a second substrate **2** larger than the first substrate **10** (see, *e.g.*, fig. 2)
5. Regarding claims 2, 6, and 8, Akita shows the component **6** including an antenna on the second substrate **2**, the antenna electrically coupled to the IC **4** directly through the medium **11** (see, *e.g.*, fig. 12).
6. Regarding claims 5, 7, 41, 56, and 59, Akita shows the conductive medium **11** is paste and the IC contains circuitry suitable for radio frequency applications (see, *e.g.*, pp.11/II.19-21).
7. Regarding claim 22, Akita shows the first substrate is a flexible material (see, *e.g.*, fig. 7).
8. Regarding claim 105, Akita shows that the opening is tapered (see, *e.g.*, pp.10/II.15-24).

9. Regarding claim 37, Akita shows all aspects of the instant invention including an apparatus comprising:

- ✓ A substrate **10** (see, e.g., fig. 12)
- ✓ An integrated circuit (IC) **4** embedded within the substrate **10** (see, e.g., fig. 3)
- ✓ A thin-film dielectric layer **36** formed over a portion of the IC **4** and a portion of the substrate **10** (see, e.g., fig. 12)
- ✓ A conductive medium paste **11** formed over a portion of the thin-film dielectric layer **36** and in direct electrical connection with the IC **4** (see, e.g., fig. 12)
- ✓ A large-scale component **6** connected to the medium **11**, coupled to the IC **4**, and including a second substrate **2** (see, e.g., fig. 2)

10. Regarding claim 38, Akita shows the substrate is a flexible material (see, e.g., fig.7).

11. Regarding claim 40, Akita shows the apparatus further comprising a large-scale component connected to the medium and electrically coupled to the IC (see, e.g., fig. 2).

12. Regarding claim 48, Akita shows the component is an antenna (see, e.g., fig. 2).

13. Regarding claim 58, Akita shows that the IC is a radio frequency identification circuit (see, e.g., pp.1/ll.1-10).

14. Regarding claim 60, Akita shows the component is a substrate having thereon an antenna coupled to the IC directly through the medium (see, e.g., fig. 2).

15. Regarding claim 111, Akita shows the apparatus comprising:

- ✓ A strap **7** including a first substrate **10** with an IC **4** having a conductive pad (see, e.g., fig. 3)

- ✓ A thin-film dielectric layer **36** formed over a portion of the IC **4** and a portion of the substrate **10** (see, e.g., fig. 12)
- ✓ A conductive medium paste **11** formed over the dielectric layer **36**, attached to the pad via a contact hole, and having a greater surface area than the pad (see, e.g., fig. 12)
- ✓ A large-scale component **11** attached to the medium **11**, electrically coupled to the IC **4**, and including a second substrate **2** (see, e.g., fig. 2)

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 9 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akita.

19. Initially, and with respect to claims 9 and 57, note that a limitation in a claim with respect to the manner in which a claimed device is intended to be used does not differentiate the claimed device from a prior-art device if the prior-art device teaches all structural limitations in the claims and the device is capable of performing the intended use. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). See *Hewlett-Packard Co. v. Bausch & Lomb Inc.* and the related case law cited therein which makes it clear that it is the final product *per se* which must be determined in a device claim, and not the patentability of its functions (909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)). As stated in *Best*,

Where the claimed and prior art products are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Note that the applicant has burden of proof once the examiner establishes a sound basis for believing that the products of the applicant and the prior art are the same. See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In the instant case, the integrated circuit could be used as a display driver, as control circuitry for an electronic display, as data storage of information, etc. In reference to the language in claims 9 and 57 referring to the function of the integrated circuit, it is noted that Akita shows all aspects of the semiconductor device according to the instant invention (see paragraphs 4- 15 above) and that using the integrated circuit as a display driver or to control an electronic display, are functions that do not affect the structure of the final device.

There are no structural implications from claiming the IC as “a display driver” or as “suitable to control an electronic display”. The claim terminologies “display driver” and “suitable to control an electronic display” are mere functional labels given to the claimed IC that do not differentiate the claimed IC from the prior art IC. These functional labels are only considered in terms of a necessary resultant structure from the labels. The functions itself are not at issue. The device claims are not limited to the recited functions of the IC. Furthermore, Akita’s device is capable of performing the claimed functions. For example, the device may receive information by means of its antenna. Since the antenna is coupled to the IC, the IC may read the information gathered by the antenna and use it to electronically control an electronic display coupled to the IC.

20. Claim 106 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akita.

21. Regarding claim 106, although Akita teaches about the importance of the conductive medium (see, e.g., pp.6/II.3-11), he fails to specify the thickness of it. The specification, on the other hand, also fails to provide teachings about the criticality of having a conductive medium with the claimed thickness. In general, thickness differences will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such thickness is critical. “Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges by routine experimentation”. *In re Aller*, 220 F.2d 454,456,105 USPQ 233, 235 (CCPA 1955). Although Akita teaches about the importance of his conductive medium, he fails to specify the thickness of it.

The specific claimed thicknesses for the conductive medium, *i.e.*, about 1 micron or less, absent any criticality, are only considered to be the "optimum" thicknesses disclosed by Akita that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired adhesive strength, manufacturing costs, etc. (see Boesch, 205 USPQ 215 (CCPA 1980)), and since neither non-obvious nor unexpected results, *i.e.*, results which are different in kind and not in degree from the results of the prior art, will be obtained as long as a conductive medium is used, as already suggested by Akita.

Accordingly, since the applicants have not established the criticality (see next paragraph below) of the claimed thicknesses, it would have been obvious to one of ordinary skill in the art to use these values in the device of Akira.

CRITICALITY

22. The specification contains no disclosure of either the critical nature of the claimed dimensions or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

23. Claim 107 is rejected under 35 U.S.C. 103(a) as being unpatentable over Akita in view of Fjelstad (US 6211572).

24. Regarding claim 107, Akita shows most aspects of the instant invention (see, *e.g.*, paragraph 4 above). As set forth above, Akita also shows a film dielectric layer (see, *e.g.*, fig. 12). Although he specifies that his dielectric layer comprises an epoxy resin (see, *e.g.*, pp.14/II.8-14), he fails to specify that it may also comprise silicon dioxide. Fjelstad (see, *e.g.*, col.5/II.49-54), on the other hand, teaches silicon dioxide to be an equivalent material to Akita's epoxy resin.

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to use either silicon dioxide or an epoxy resin in Akita's apparatus because these were recognized in the semiconductor art for their use as dielectric materials, as taught by Fjelstad, and the selection of any of these known equivalents would be within the level of ordinary skill in the art.

Response to Arguments

25. The applicants argue:

Layer 36 of Akita is not a dielectric layer but an epoxy resin layer which does not function as a dielectric layer as can be best understood by the applicants.

The examiner responds:

The epoxy resin layer of Akita is a dielectric layer.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(571) 273-8300**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

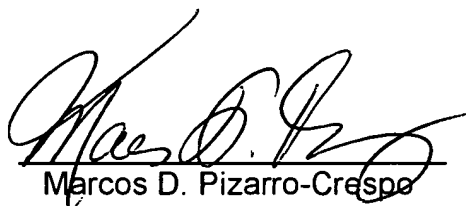
28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(571) 272-1716** and between the hours of 10:00 AM to 8:30 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Marcos.Pizarro@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (571) 272-1705.

29. Any inquiry of a general nature or relating to the status of this application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2814

30. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 257/678-786	8/19/2006
Other Documentation:	
Electronic Database(s): EAST (USPAT, EPO, JPO)	8/19/2006



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MDP/mdp
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